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TO: Examiner Jeanine A. Goldberg

THE FIRM'S FACSIMILE TRANSMITTERS:

GROUP UNIT: 1634

SERIAL NO: 09/488,442

FROM: David A. Jackson

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DATE: August 1, 2003

PAGES TO FOLLOW: 6

MESSAGE:

File No. 600-1-195B

Fax Tel. No. (703) 746-5149

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### Applicant Initiated Interview Request Form

Application No.: 09/ 488,442 First Named Applicant: James E. Darnell, Jr.  
Examiner: Jeanine Goldberg Art Unit: 1634 Status of Application: Final Rejection

**Tentative Participants:**

(1) Jeanine Goldberg (2) David A. Jackson  
(3) Sarah J. Fashena (4) \_\_\_\_\_

Proposed Date of Interview: August 4, 2003 Proposed Time: 10:30 (AM/PM)

**Type of Interview Requested:**

(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES ☒ NO

If yes, provide brief description: \_\_\_\_\_

### Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Rejection</u>	<u>1, 97, 108-113, and 115-119</u>	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Continuation Sheet Attached

**Brief Description of Arguments to be Presented:**

The description in the application recites a specific and established utility meeting the utility guidelines and that there is sufficient description and enablement. A supplemental IDS is now correctly transmitted that presents evidence supporting applicants' position.

An interview was conducted on the above-identified application on \_\_\_\_\_.

**NOTE:**

This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

\_\_\_\_\_  
(Applicant/Applicant's Representative Signature)

\_\_\_\_\_  
(Examiner/SPE Signature)

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT(S): Darnell, Jr. et al.

SERIAL NO.: 09/488,442

EXAMINER: Jeanine Anne Goldberg

DATE FILED: January 20, 2000

ART UNIT: 1634

FOR: RECEPTOR RECOGNITION FACTORS, PROTEIN SEQUENCES, AND  
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COMMISSIONER FOR PATENTS, ALEXANDRIA, VA 22313-1450 on August 1, 2003.Betty Schultz  
(Name of depositor)Betty Schultz 8/1/03  
(Signature and Date)MAIL STOP AFTER FINAL  
COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450

Sir:

**RENEWED TRANSMITTAL OF  
SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

The present transmittal is in furtherance to and in support of the entry of the Supplemental Information Disclosure Statement that was submitted by certificate of mailing on March 26, 2003, and which has been denied entry and consideration in the Advisory Action of April 15, 2003, in part because of the absence of proper reference and a petition for consideration that is requisite for such documents that are submitted after final rejection. Accordingly, the present transmittal is submitted to correct the objections raised with regard to the originally submitted supplemental information disclosure statement, and to gain the entry and consideration thereof. Copies of the form PTO-1449 and the corresponding references are not submitted herewith in as much as they are already present in the file.

Accordingly, in accordance with Applicants' and Applicants' representatives' Duty of Disclosure under 37 CFR § 1.56, and pursuant to 37 CFR §1.97 and MPEP 717.05(b), Applicants

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request the entry of documentary information for consideration by the Examiner, which documentary information was previously submitted and received. The publications that were forwarded have been listed on a Form PTO-1449 also earlier filed. Applicant requests that the Examiner, upon reviewing the materials in object, initial the Form PTO-1449 and return a copy thereof in accordance with the instructions on the form.

The references listed on the Form PTO-1449 are being brought to the attention of the Examiner for consideration in connection with the examination of the above-identified patent application, in the manner and for the purpose set forth herein below.

Petition for Consideration of the Information Disclosure Statement Under 37 C.F.R. §1.97(d)

Applicants hereby request consideration of the present Information Disclosure Statement, which was submitted after the mailing date of the Final Action under 37 C.F.R. §1.113.

Certification Under 37 C.F.R. § 1.97 (e)(2) and §1.98(d)

The undersigned attorney for applicants hereby certifies that no item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and more importantly, that the references and their purpose entitles them to entry and consideration at this time.

Specifically, the references that were submitted previously are not per se deemed to be relevant to the patentability of the claimed invention, in the sense that they should be cited in the file so as to assure that Applicant has complied with its duties under 37 C.F.R. §§ 1.56 and 1.97. The references that were submitted previously are, instead, being advanced in corroboration of Applicants' position with respect to the compliance of the present Specification as to the presentation of a specific and substantial utility, and particularly, to advance that the uses of the present materials were known by those skilled in the art at a time contemporaneous with the filing of the present application, and that neither undue experimentation nor extensive extrinsic instruction would be required for the artisan to practice the asserted inventions. As such, the

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references are not believed to require consideration in accordance with the guidelines of either 37 C.F.R. § 1.56 or 37 C.F.R. § 1.97.

In particular, one of the references in question comprises a journal article by Darnell and co-workers. While the co-inventor hereof has known of the article and its substance, its application in the context of the present invention in corroboration and support of patentability by its demonstration of the level of skill of the art, was not previously considered, recognized or even identified for this purpose. As such, it is submitted that the information in this article was not considered to be "material to the present application" in any of the contexts discussed herein.

It is Applicants understanding that the terms of 37 C.F.R. § 1.56, defining the duty of the individuals associated with the filing and prosecution of a patent application, intends that "...the duty applies to contemporaneously or presently known information. The fact that information was known years ago does not mean that it was *recognized* that information is *material to the present application*" (emphasis added) (see M.P.E.P. §2001.04).

Moreover, and as stated earlier, applicants understand that the rules and corresponding requirements attendant to the submission and consideration of information in accordance with 37 C.F.R. § 1.56, is "... *not* intended to require information *favorable* to patentability such as, for example, ... disclosure of information concerning the level of skill in the art for purposes of determining obviousness" (Id.)

Thus, Applicants believe that the references that were submitted are appropriately considered at this time and that the purpose of the present Information Disclosure Statement is merely to corroborate the patentability and sufficiency of present application.

#### Fee

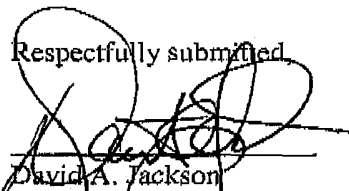
The fee required for filing this Renewed Transmittal of Supplemental Information Disclosure Statement has been previously remitted so that no further payments are believed to be required at this time. However, should additional fees be required, authorization is hereby given to charge any additional fees or credit any overpayments, to Deposit Account 11-1153 of the undersigned.

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In as much as a copy of the References **BW** through **CF** have been provided to the Examiner, with the previous submission, a further submission at this time is not deemed to be warranted. Should the Examiner wish a copy of any or all references, they will be promptly provided upon her request.

It is respectfully requested that the Examiner make these references of record, and to indicate consideration thereof by returning a copy of the Form PTO-1449 with initials or other appropriate marks.

Respectfully submitted,

  
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Attorney for Applicants  
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Date: August 1, 2003